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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1994

QUALITEX COMPANY,

*Petitioner*,

—v.—

JACOBSON PRODUCTS COMPANY, INC.,

*Respondent*.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

## BRIEF FOR OWENS-CORNING FIBERGLAS CORPORATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

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## BRIEF FOR OWENS-CORNING FIBERGLAS CORPORATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

### Consent of Parties

Petitioner and respondent have consented to the filing of this brief, and their letters of consent are being filed separately herewith.

### Interest of the *Amicus Curiae*: Owens-Corning's Use of its Pink Trademark to Identify and Promote its Goods

*Amicus curiae* Owens-Corning Fiberglas Corporation ("Owens-Corning") is the largest manufacturer of residential

fiberglass insulation in the United States. In 1993, Owens-Corning sold in excess of $500 million of the product, enough fiberglass to insulate more than 800,000 single family homes. All of that insulation was colored pink. That pink color serves as an instantly recognizable trademark. Owens-Corning has colored its residential fiberglass insulation pink since 1956. It is the only fiberglass insulation manufacturer that colors its product; all of the other manufacturers sell their cured insulation in its natural, yellow state.

In 1985, the United States Court of Appeals for the Federal Circuit ruled in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985), that Owens-Corning was entitled to federal registration under the Lanham Act for the color pink as a trademark for its residential fiberglass insulation products. In 1993, that federal registration (No. 1,439,132) became incontestable under Section 15 of the Lanham Act.

The decision of the Ninth Circuit in *Qualitex Co.* v. *Jacobson Products Co.*, 13 F.3d 1297 (9th Cir. 1994), under review by this Court is directly at odds with the Federal Circuit's ruling in *In re Owens-Corning* and threatens to deprive Owens-Corning of the goodwill represented by its distinctive trademark and to invite consumer confusion. Owens-Corning urges this Court to reverse the Ninth Circuit's ruling that the Lanham Act does not permit the registration of a color mark under any circumstances.

Owens-Corning's use of a pink trademark to identify and promote its products is a paradigm case showing that registration of a color mark "foster[s] competition and the maintenance of quality by securing to the producer the benefits of good reputation." *Park'N Fly, Inc.* v. *Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 (1985). Its experience also shows that the Ninth Circuit's blanket denial of registration cannot be reconciled with the "contemporary marketing practices" that Congress meant the statute to accommodate. S. Rep. No. 515, 100th Cong., 2d Sess. 44 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5607.



On a nationwide basis, in each and every relevant market Owens-Corning has promoted the unique color of its residential fiberglass insulation as the trademark symbol for the quality of both the product and the company standing behind it. At the consumer level, Owens-Corning uses television and magazine advertisements, promotional literature and items, point-of-sale materials and a consumer hotline, "1-800-GET-PINK," to reinforce the image of Owens-Corning pink fiberglass as a quality product that provides the best thermal and sound control performance available. The company has spent at least $400 million on consumer and cooperative advertising during the period from 1972 through 1994. *All* of this advertising features pink.

Indeed, since *In re Owens-Corning* was decided in 1985, the company has spent at least $200 million on consumer and cooperative advertising and promotions incorporating Owens-Corning's pink trademark. Plainly, Owens-Corning has expended vast sums in reliance on the decision.

These efforts have been extremely successful with the public. As stated in *In re Owens-Corning*, a January 1981 survey showed that 50% of male homeowners identified Owens-Corning as the manufacturer of pink insulation. 774 F.2d at 1127. Consumer identification is even higher today.

The promotion of pink as the trademark for Owens-Corning residential fiberglass insulation is equally pervasive to the trade. Retailers, insulation contractors and distributors know that because of Owens-Corning's extensive advertising, it is easier to sell pink insulation to builders and the "do-it-yourself" market. And builders know that by using Owens-Corning pink insulation they can assure prospective home buyers that they used quality building products. The trade also knows that when they buy pink insulation, they are buying a product that has been subjected to rigorous quality control and that will perform in accordance with its specifications. They know that they are dealing with a company that is strongly committed to research and development and that is responsible for

a number of technical and product innovations that make pink insulation easier to use, handle and store. And they know that they are dealing with a company dedicated to customer service and support through its sales force, engineering and management consulting staffs, training workshops, and a "1-800-PINK-PRO" hotline for trade customers.

The bottom line is that among consumers, "pink" is synonymous with "Owens-Corning" for residential fiberglass insulation. Given this wide recognition and acceptance of Owens-Corning's pink trademark for fiberglass insulation, the consequences to Owens-Corning from a decision upholding the Ninth Circuit in *Qualitex* would be severe. Loss of trademark protection for the pink mark could free Owens-Corning's competitors to begin manufacturing pink insulation of their own. Trade dress protection is not a substitute for trademark protection.

Among other things, registration provides a trademark owner with *prima facie* evidence of the validity of its mark and of its "exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration." 15 U.S.C. § 1115(a). Moreover, "in a registered trademark infringement case, the court must look at a *single* aspect of the product — the trademark itself — a court in [a] trade-dress infringement case must look at the product as a whole." *Qualitex*, 13 F.3d at 1303. Thus, if the Ninth Circuit is not reversed, a competitor could produce pink fiberglass and argue on the basis of the "total impression of the package, size, shape, color, design, and name," 13 F.3d at 1303, that Owens-Corning's trade dress was not being infringed.

Competitors could thus attempt to benefit from the goodwill and reputation that Owens-Corning has cultivated. The problem would be particularly acute for a product like residential fiberglass insulation. Once installed, all pink insulation would look alike; variations in quality could only be detected through sophisticated testing. Homeowners who would see a competitor's pink insulation in their attics would falsely believe that they



have Owens-Corning insulation. The problem is compounded by the fact that many of the support services that Owens-Corning uses to distinguish its product are provided free of charge. As a result, the trade could avail itself of Owens-Corning's free support services and purchase a competitor's pink product.

The inevitable result of a loss of protection for Owens-Corning's valuable trademark would be a diminution in the ability of the company to capture the economic benefits that quality control, technical innovation and customer service would otherwise bring it — all to the ultimate detriment of consumers. This is precisely the sort of harm that Congress was seeking to prevent in adopting and in recently amending the Lanham Act, and precisely the reason why Owens-Corning has a unique interest in the reversal of the Ninth Circuit's ruling in *Qualitex*.

## Summary of Argument

In its most recent decisions construing the Lanham Act, this Court has established two overriding principles that dictate the outcome of this case: (1) that the courts should give effect to the plain meaning of the Act; and (2) that the courts are not free to write policy-based restrictions into the Act in contravention of its express terms. *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992); *Park'N Fly, Inc.* v. *Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985). The Ninth Circuit's decision in *Qualitex* cannot be reconciled with either of these principles.

Section 45 of the Lanham Act permits the registration of any "symbol, or device" that is "used by a person" "to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods." 15 U.S.C. § 1127. Color can and does serve this function and therefore can be registered as a trademark. Section 2 of the Lanham Act supports this conclusion; it provides that no trademark can be refused registration "on account of its nature" except as Section 2 expressly provides. 15 U.S.C. § 1052. Color is not one of the listed exceptions. Permitting

the registration of color marks is also supported by the legislative history of the Lanham Act and particularly that of the 1988 amendments to the Act which, with unusual clarity, indicates that Congress defined "trademark" broadly "so as not to preclude the registration of colors . . . where they function as trademarks." S. Rep. No. 515, 100th Cong., 2d Sess. 44 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5607. Registrability of color marks is also consistent with the construction of the Act by the Patent and Trademark Office, the agency that Congress charged with administering its registration provisions. 15 U.S.C. § 1062; 35 U.S.C. § 6. That agency's interpretation is entitled to deference. *See Chevron U.S.A. Inc.* v. *Natural Resources Defense Council, Inc.*, 467 U.S. 837, 842-45 (1984).

The "policy" concerns upon which the Ninth Circuit based its conclusion "that the better rule is that a trademark should not be registered for color alone," 13 F.3d at 1302, cannot justify its decision. Absent some constitutional prohibition, courts must abide by the legislative judgments that have been made by Congress and cannot deviate from those judgments on "policy" grounds. The Ninth Circuit's "better rule" approach is a species of impermissible "federal-common-law-making" recently condemned by this Court in *O'Melveny & Myers* v. *FDIC*, 114 S. Ct. 2048 (1994). It is particularly problematic given that the judicially-determined "better rule" is at odds with Congress' fundamental objective in enacting the Lanham Act: to liberalize the registration of trademarks and make trademark law consistent with contemporary commercial practices.

Moreover, the substance of the "policy concerns" that led the Ninth Circuit to its decision cannot be credited. While professing concern about so-called "color depletion," the Ninth Circuit acknowledged "that there are countless shades of colors that could not be depleted." 13 F.3d at 1302. And in concluding that "shade confusion" would "present unnecessary problems," 13 F.3d at 1302, the Ninth Circuit apparently lost sight of the fact that Congress passed the Lanham Act to protect consumers against confusion and companies like



Owens-Corning from unfair competition, not to protect courts from having to deal with "problems." In any event, the "problem" that the Ninth Circuit perceived is not a real one. Distinguishing between color shades is no more difficult than deciding whether word marks are confusingly similar. *See Master Distributors, Inc.* v. *Pako Corp.*, 986 F.2d 219, 223 (8th Cir. 1993); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1123 (Fed. Cir. 1985).

## Argument

## POINT I

## THE LANHAM ACT PERMITS THE REGISTRATION OF COLOR AS A TRADEMARK.

The plain language, legislative history and administrative interpretation of the Lanham Act demonstrate that Congress intended to permit the registration of color marks. The Ninth Circuit simply ignored the language of the statute, its legislative history and its basic purpose to create a policy-based, *per se* prohibition against the registration of color.

### A. The language, legislative history and administrative interpretation of the Lanham Act show that Congress intended to permit the registration of color as a trademark.

The starting point for determining whether color can be registered as a "trademark" under the Lanham Act is the plain language of the statute. *Park'N Fly, Inc.* v. *Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985) ("Statutory construction must begin with the language employed by Congress and the assumption that the ordinary meaning of that language accurately expresses the legislative purpose."); *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 112 S. Ct. 2753, 2760 (1992).

The Lanham Act provides for the federal registration of "trademarks" and a comprehensive scheme of substantive and

procedural protections for "trademarks." 15 U.S.C. §§ 1052 (registrability), 1065 (incontestability), 1114 (remedies), 1115 (evidentiary presumptions), 1116 (injunctions). Under the heading "Construction and Definitions," Section 45 of the Act defines a "trademark" to include "any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127.

It is readily apparent that "color" falls within this statutory definition. As demonstrated by Owens-Corning's "use" of pink detailed above, color is a "symbol" or "device" that can be used to "identify and distinguish" goods and to indicate their source.

Indeed, the conclusion that color fits within the statutory definition of "trademark" does not depend upon a finding that color is a "symbol" or "device." Section 45 provides that a trademark "*includes* any word, name, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods." As the Seventh Circuit has recently held, the definition does not *limit* registrable trademarks to the specifically included items. *Kohler Co.* v. *Moen Inc.*, 12 F.3d 632, 635 (7th Cir. 1993) (Congress' use of the word "includes" indicates that "trademarks" are not limited to "words, names, symbols or devices"). *See also American Surety Co.* v. *Marotta*, 287 U.S. 513, 517 (1933) (the word "include" in statutes is "used as a word of extension or enlargement rather than as one of limitation or enumeration"). Thus, so long as color is "used" to "identify or distinguish goods," it functions as a "trademark" and is entitled to registration.

Section 2 confirms that the Lanham Act permits color to be registered as a trademark. Pursuant to that Section, no trademark can be refused registration "on account of its nature" except as Section 2 expressly provides. Color is not one of the specifically excluded categories. 15 U.S.C. § 1052. A *per se*



rule precluding the registration of color plainly is a prohibition "on account of its nature" that is forbidden by Section 2. Creating an exception for color would constitute a judicial amendment to add a category that Congress chose to omit. Courts are not authorized to engage in this type of "federal-common-law-making." *O'Melveny & Myers* v. *FDIC*, 114 S. Ct. 2048, 2054-55 (1994) (courts may not alter statutory scheme by creating "additional 'federal common-law' exceptions"). *See also Arkansas Best Corp.* v. *Commissioner*, 485 U.S. 212, 217-18 (1988) (when Congress provides for certain exceptions, courts are not free to fashion additional ones); *Andrus* v. *Glover Construction Co.*, 446 U.S. 608, 616-17 (1980) ("Where Congress explicitly enumerates certain exceptions to a general prohibition, additional exceptions are not to be implied, in the absence of evidence of a contrary legislative intent.").

The legislative history of Section 45 also confirms that the statutory definition of "trademark" was intended to include color. In 1988, Congress passed the Trademark Law Revision Act of 1988, Pub. L. 100-667 (hereinafter, the "1988 Act"). One of the major purposes of the 1988 Act was to "bring the trademark law up-to-date with present day business practices." S. Rep. No. 515, 100th Cong., 2d Sess. 44 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577. To that end, the definition of "trademark" in Section 45 was "broadened to reflect contemporary marketing practices and to make clear a trademark's function of distinguishing the goods of one person from those of another." 1988 U.S.C.C.A.N. at 5607. In commenting on these changes, the Senate Report stated that the revised definition "intentionally retain[ed]. . . the words 'symbol or device' *so as not to preclude the registration of colors*, shapes, sounds or configurations *where they function as trademarks*." 1988 U.S.C.C.A.N. at 5607 (emphasis added).

Plainly, when both the language of a statute indicates a certain result *and* where the legislative history of the statute

expressly *endorses that same result*, the courts must accept that Congress has definitively addressed the issue. Indeed, that was precisely the basis for this Court's decision in *Park'N Fly*, where it relied on the language and legislative history of Sections 15 and 33(b) of the Lanham Act to reverse the Ninth Circuit and hold that an alleged infringer of an incontestable trademark is entitled to assert only those defenses enumerated in the statute. 469 U.S. at 196-202. Similarly, this Court in *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992), found that there was no "textual basis in § 43(a) for treating inherently distinctive verbal or symbolic trademarks differently from inherently distinctive trade dress," and, consequently, refused to write such a provision into the Lanham Act. 112 S. Ct. at 2760.

The conclusion that color can be registered as and receive the protections afforded a "trademark" is further supported by the fact that the Patent and Trademark Office has interpreted the Lanham Act to permit the registration of color marks. *See In re Owens-Corning*, 774 F.2d at 1118 (noting that the Trademark Trial and Appeal Board has "held that the overall color of goods is capable of functioning as a trademark"); *Edward Weck Inc.* v. *IM Inc.*, 17 U.S.P.Q.2d 1142, 1145 (T.T.A.B. 1990) ("no inherent bar to trademark registration of the overall color of goods"); *In re Eagle Fence Rentals, Inc.*, 231 U.S.P.Q. 228, 231 (T.T.A.B. 1986) ("when color is applied to goods in an arbitrary manner or design, it can function as [a] trademark").

Since Congress has delegated the duty to administer the Lanham Act, including the authority to promulgate rules implementing the Act, to the Patent and Trademark Office, the Ninth Circuit was obliged to defer to any permissible interpretation of the statute issued by that Office. *Chevron U.S.A. Inc.* v. *Natural Resources Defense Council, Inc.*, 467 U.S. 837, 843-44 (1984); *Kohler Co.* v. *Moen Inc.*, 12 F.3d 632, 635-36 (7th Cir. 1993) (deferring to Patent and Trademark Office's construction of Section 45 of the Lanham Act).



*See* 15 U.S.C. § 1062 (Patent and Trademark Office determines whether a particular mark qualifies for registration); 35 U.S.C. § 6 (1988) (granting Patent and Trademark Office the authority to issue regulations). There is no doubt that one "permissible" interpretation of the Lanham Act would permit the registration of color. The Ninth Circuit erred by rejecting this construction and substituting its view of what marks should be subject to registration. *See Chevron*, 467 U.S. at 844 ("a court may not substitute its own construction of a statutory provision for a reasonable interpretation made by the administrator of an agency").

Given the language of the Act, its legislative history and the authoritative interpretation of the responsible administrative agency, it is no surprise that the three courts that have followed this Court's teaching on statutory construction have all concluded that the definition of "trademark" encompasses color. In the leading opinion, *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1118-20 (Fed. Cir. 1985), the Federal Circuit noted that Section 45 represented a departure from prior trademark law "as prior statutes only permitted the registration of 'technical' common law trademarks." 774 F.2d at 1119.[1] The Federal Circuit reasoned that when Congress changed the definition of trademark, "registration became available to many types of previously excluded indicia." 774 F.2d at 1119-20 & nn.1-9. As a result, "[t]he jurisprudence under the Lanham Act developed in accordance with the statutory principle that if a mark is capable of being or becoming distinctive of [an] applicant's goods in commerce,

[1] *See also In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973) (Lanham Act dispensed with "technical prohibitions and arbitrary provisions"); Restatement (Third) of Unfair Competition § 9, cmt. f. (Tent. Draft No. 2, March 23, 1990) (trademarks at common law were "limited to inherently distinctive designations such as fanciful or arbitrary words used by a seller to identify the source of its goods").

then it is capable of serving as a trademark." 774 F.2d at 1120. Since color can serve to identify and distinguish products and to indicate their source, the Federal Circuit concluded that "[c]olor marks, as other indicia, were no longer barred from registration." 774 F.2d at 1120.

Likewise, the Court of Appeals for the Eighth Circuit analyzed the language of the Act and its legislative history to conclude that there was no "per se prohibition against protecting color alone as a trademark." *Master Distributors, Inc.* v. *Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993). *See also DAP Products, Inc.* v. *Color Tile Mfg., Inc.*, 821 F. Supp. 488, 494 (S.D. Ohio 1993) ("no absolute prohibition on the registrability of color marks").

On the other hand, courts that have denied Lanham Act protection to color have done so without reference to the language or the legislative history of the Act. For example, in *Qualitex*, even though the Ninth Circuit recognized that registration of a color is *not* prohibited by the Lanham Act, it nonetheless held that color could not be the basis of a trademark. 13 F.3d at 1301. The analysis of the Seventh Circuit in *NutraSweet Co.* v. *Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991), was equally defective; the opinion merely cites to a case decided in 1950 and concludes without reference to either the statute or its legislative history that "[c]onsistency and predictability" provide compelling reasons for refusing to depart from that precedent. 917 F.2d at 1027. These rulings disregarded cardinal principles of statutory construction that a court's responsibility is to "construe and apply the provisions Congress enacted," not "to evaluate the wisdom of the legislative determinations reflected in the statute." *Park'N Fly, Inc.*, 469 U.S. at 203. *See also Northwest Airlines, Inc.* v. *Transport Workers Union of America*, 451 U.S. 77, 97 (1981) ("authority to construe a statute is fundamentally different from the authority to fashion a new rule or to provide a new remedy which Congress has decided not to adopt").



### B. Permitting the registration of color as a trademark is consistent with the purposes of the Lanham Act.

Registration of color is also appropriate because it would further the purposes of the Lanham Act "to secure to the owner of the mark the goodwill of his business" and "to protect the ability of consumers to distinguish among competing producers." *Park'N Fly, Inc.* v. *Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 (1985). Broad protection is necessary to advance these purposes. As this Court stated in *Park'N Fly*:

> Because trademarks desirably promote competition and the maintenance of product quality, Congress determined that "a sound public policy requires that trademarks should receive nationally the greatest protection that can be given them."

469 U.S. at 193 (quoting S. Rep. No. 1333, 79th Cong. 2d Sess. (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1277).

The registration of color marks in appropriate cases advances these legislative purposes. Owens-Corning's use of the color pink proves the point. Pink instantly identifies Owens-Corning residential fiberglass insulation and distinguishes it from insulation sold by other manufacturers. *In re Owens-Corning*, 774 F.2d at 1123. Pink assists in the advertisement and sale of Owens-Corning's insulation and embodies the goodwill that the company has developed for its brand through product innovation and quality control. 774 F.2d at 1125-27. As Judge Posner has observed, the "purpose of a trademark, after all, is to identify a good or service to the consumer." *Gorenstein Enterprises* v. *Quality Care-USA, Inc.*, 874 F.2d 431, 435 (7th Cir. 1989). Plainly, color can, and does, serve this function.[2]

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[2] Judge Posner has written that, from an economic perspective, color should be entitled to registration. W. Landes & R. Posner, *Trademark Law: An Economic Perspective*, 30 J. Law & Econ. 265, 290 (1987) ("[C]olor now primarily provides source information; in trademark

(*footnote continued*)

This is not to say that the use of a certain color will always result in a trademark registration. The Patent and Trademark Office has established substantive standards for the examination of applications seeking to register color marks. Trademark Manual of Examining Procedure § 1202.04(e) (2d ed. 1993).[3] And the Office has not shown any hesitation in refusing to register color marks where these standards have not been met. *See, e.g., Edward Weck Inc.* v. *IM Inc.*, 17 U.S.P.Q.2d 1142 (T.T.A.B. 1990) (refusing registration for color green as applied to disposable plastic instruments where no proof of secondary meaning); *British Seagull Ltd.* v. *Brunswick Corp.*, 28 U.S.P.Q.2d 1197 (T.T.A.B. 1993) (refusing to register color black as applied to marine outboard engines where black was functional and lacked secondary meaning), *aff'd*, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994). However, when color *is* used to identify and distinguish a producer's goods, it *is* a trademark, and affording that trademark the protections provided by Congress protects consumers and producers.

The Ninth Circuit concluded that even without the right to register a color mark, the policies underlying the Lanham Act can be vindicated by providing relief under the general unfair competition provision of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125. That conclusion was incorrect. Some courts have refused to allow a Section 43(a) claim that is based on "mere color." *See, e.g., NutraSweet Co.* v. *Stadt Corp.*, 917

(*footnote continued*)
jargon it has acquired secondary meaning. Not to allow exclusive use in these circumstances would destroy information capital should other producers start using the same signifier.")

[3] Section 1202.04(e) of the Manual provides that an applicant seeking to register color as a trademark bears the "substantial" burden of showing that: (a) color "is used on the goods in the manner of a trademark" and "is perceived by the purchasing public as identifying and distinguishing the goods on which it is used and indicating their source"; (b) "the proposed color mark has become distinctive of the applicant's goods in commerce"; and (c) there is no "competitive need for colors to remain available in the industry."



F.2d 1024 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991) (refusing to extend Section 43(a) protection to color). Moreover, the protection afforded by Section 43(a) is not as strong as the protection afforded a registered trademark: registration is *prima facie* evidence of the validity of the mark and the trademark owner's "exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration." 15 U.S.C. § 1115(a).[4] And as *Qualitex* acknowledges, in a registered trademark case, the court would focus on the "*single* aspect of the product — the trademark itself" in assessing the likelihood of confusion, whereas in a "trade-dress infringement case" the court would "look at the product as a whole." 13 F.3d at 1303. Given this different focus, in a trade dress case a competitor could argue that while it was using the same color that identifies its competitor's goods, it had taken other steps to diminish the likelihood that consumers would confuse the source of the goods and that its use of its competitor's color was therefore permissible. The protection of consumers that Congress sought to achieve thus would be jeopardized.

## POINT II

## THE ARGUMENTS ADVANCED AGAINST TRADEMARK PROTECTION FOR COLOR DO NOT WARRANT A *PER SE* RULE AGAINST REGISTRABILITY.

Those courts that have adopted a *per se* rule against Lanham Act protection for color have relied principally on two ratio-

[4] The right to register also provides a trademark owner with additional protections, including: (1) the ability to establish *prima facie* ownership of its mark in an infringement action, 15 U.S.C. § 1057(b); (2) constructive notice throughout the United States of its claim to the mark, 15 U.S.C. § 1072; (3) the benefit of the incontestability provisions of the Lanham Act, 15 U.S.C. § 1065; (4) the opportunity to prevent the importation of counterfeit goods by recording a registered mark with the Department of the Treasury, 15 U.S.C. § 1124; and (5) the ability to obtain an *ex parte* order seizing goods labeled with counterfeit marks, 15 U.S.C. § 1116(d)(1).

nales: "color depletion" and "shade confusion." *See, e.g., Qualitex Co.* v. *Jacobson Products Co.*, 13 F.3d 1297, 1302 (9th Cir. 1994); *NutraSweet Co.* v. *Stadt Corp.*, 917 F.2d 1024, 1027-28 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991). Neither doctrine has any support in the language or legislative history of the Lanham Act. Both "color depletion" and "shade confusion" are policy-based, court-made rules that conflict with Congress' objective of "making registration 'more liberal,' dispensing with 'mere technical prohibitions and arbitrary provisions' and modernizing the trademark statutes 'so that they will conform to legitimate present-day business practice.' " *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973) (quoting S. Rep. No. 1333, 79th Cong. 2d Sess. (1946), *reprinted in* 1946 U.S.S.C.A.N. 1274, 1276-77). But beyond that, neither the "color depletion" nor the "shade confusion" doctrine has any footing in modern commercial practices.

### A. The "color depletion" theory cannot justify a *per se* ban.

The "color depletion" theory was first stated in *Diamond Match Co.* v. *Saginaw Match Co.*, 142 F. 727 (6th Cir.), *cert. denied*, 203 U.S. 589 (1906), a case decided some 40 years before passage of the Lanham Act. The theory takes the view that there is a limited number of colors in the spectrum, and that granting trademark protection for a particular color creates the risk that available colors would run out, and "new entrants would be deterred from entering the market." *NutraSweet Co.* v. *Stadt Corp.*, 917 F.2d 1024, 1028 (1990). This concern is baseless.

*First*, "color depletion" erroneously assumes that there are not enough colors to sustain competition. In fact, as a result of modern developments in dye technology there are scores if not hundreds of distinct colors available for use. That was not true when *Saginaw Match* was decided. *See Dap Products, Inc.* v. *Color Tile Mfg., Inc.*, 821 F. Supp. 488, 495 (S.D. Ohio 1993) (color depletion "is not a persuasive theory in light of



available contemporary technology. There are a myriad of colors and shades available for products today that were certainly not available in the past."). *See also* A. Kornerup & J.H. Wanscher, *Color Atlas* 7 (Reinhold 1962) (containing the names and samples of 1,266 colors); K. Kelly & D. Judd, *The ISCC-NBS Method of Designating Colors and a Dictionary of Color Names* 4 (National Bureau of Standards, Circular 553, Government Printing Office 1955) (recognizing 7,500 distinct color names). *See generally* I. Cooper, *Trademark Aspects of Pharmaceutical Product Design*, 70 Trademark Rep. 1, 22-25 (1980) (noting that there is virtually an unlimited number of hues between the primary colors on the color spectrum).

The likelihood of exhausting all the shades of color is thus remote at best. As the Eighth Circuit has observed, "[u]ntil secondary meaning has been established in every distinguishable shade of color and in no color at all, *a highly improbable situation*, there will always be an option available to a new market entrant." *Master Distributors, Inc.* v. *Pako Corp.*, 986 F.2d 219, 223 (8th Cir. 1993) (emphasis added). Even the Ninth Circuit in *Qualitex* acknowledged "that there are countless shades of colors that could not be depleted." 13 F.3d at 1302.

*Second*, the theory as originally conceived erroneously assumed that a registration would be granted for a primary color "in all of its shades." *Campbell Soup Co.* v. *Armour & Co.*, 175 F.2d 795, 798 (3d Cir.), *cert. denied*, 338 U.S. 847 (1949). *See Saginaw Match Co.*, 142 F. at 729. But that is not how the Patent and Trademark Office handles applications. Instead, registrations are granted for a particular color as it is applied to a particular product. Trademark Manual of Examining Procedure § 1202.04(e).

*Third*, to the extent "color depletion" is concerned with competition, the Patent and Trademark Office's regulations prohibit the registration of a color mark where there is a competitive need for color in an industry. Trademark Manual of Examining Procedure § 1202.04(e). Those regulations essen-

tially apply the functionality doctrine to determine whether alternative colors are available to competitors. *See British Seagull Ltd.* v. *Brunswick Corp.*, 28 U.S.P.Q.2d 1197, 1199 (T.T.A.B. 1993) ("When we consider whether a color is functional we must consider *whether alternative colors are available in order to avoid the fettering of competition*. If competition will be hindered, the color in question is de jure functional.") (emphasis added), *aff'd*, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994). And if it is determined that a particular color is functional, registration will be refused. Trademark Manual of Examining Procedure § 1202.04(e); *Brunswick Corp.* v. *British Seagull Ltd.*, 32 U.S.P.Q.2d 1120, 1123 (Fed. Cir. 1994) ("if the use of color on the applicant's goods serves a non-trademark purpose that hinders competition, the de jure functionality doctrine precludes trademark protection").

*Finally*, there is no basis for making the "color depletion" concern a basis for denying registration in circumstances where there is no realistic possibility that "color depletion" could in fact take place. For example, Owens-Corning is the only manufacturer that uses color to distinguish its residential fiberglass insulation product; innumerable colors are available for any manufacturer (old or new) that wants to color its insulation. Using "color depletion" to deprive Owens-Corning and others similarly situated of their color registrations in these circumstances would amount to sacrificing the concrete benefits of registration to entirely speculative and conjectural fears.

### B. The "shade confusion" problem cannot justify a *per se* ban.

The other reason offered for a *per se* rule against trademark protection for color is the "shade confusion" theory: the supposed difficulty involved in distinguishing close shades of color. As stated by the Ninth Circuit in *Qualitex*, "[d]rawing distinctions between close shades of color could present unnecessary problems." *Qualitex*, 13 F.3d at 1302. But even if one assumed that distinguishing between shades of color can



create "problems," that would not justify denial of Lanham Act protection. Congress legislated to protect consumers from confusion and producers from unfair competition, not courts from having to deal with "problems." Congress has presented the courts with challenges before, and no doubt will do so in the future.

In any event, the notion that distinguishing between shades of color will present problems is highly dubious. The Patent and Trademark Office already distinguishes between shades of color without any apparent difficulty. *See In re Hodes-Lange Corp.*, 167 U.S.P.Q. 255 (T.T.A.B. 1970) (comparing a "brilliant yellow" band with a "bronzy gold" band); *Amsted Industries, Inc.* v. *West Coast Wire Rope & Rigging, Inc.*, 2 U.S.P.Q.2d 1755 (T.T.A.B. 1987) (comparing two adjacent wire rope strands of yellow to two adjacent strands of yellow and yellowish-green); *Youngstown Sheet & Tube Co.* v. *Tallman Conduit Co.*, 149 U.S.P.Q. 656 (T.T.A.B. 1966) (comparing gold band on one producer's sewer pipe with another's orange band).

There is no reason why courts could not do the same, particularly since organized color schemes and professional colorists are available to assist in differentiating one shade from another. *See Master Distributors, Inc.*, 986 F.2d at 224 ("as with any technical issue, expert witnesses are available to testify regarding the similarity of the colors at issue"); *Olay Co.* v. *Cococare Products, Inc.*, 218 U.S.P.Q. 1028, 1045 (S.D.N.Y. 1983) (court ordered that defendant use a "discernibly different pink" on its packaging). *See also* W.H. Peacock, *The Practical Art of Color Matching* 7 (American Cyanamid Co. 1953); A. Maerx & M.R. Paul, *A Dictionary of Color* 11-13 (McGraw-Hill 1950) (providing a step-by-step method for matching colors).

Moreover, "likelihood of confusion" is always an issue in trademark cases. The Federal Circuit was surely correct in concluding that " '[d]eciding likelihood of confusion among color shades . . . is no more difficult or subtle than

deciding likelihood of confusion where word marks are involved.' " *In re Owens-Corning*, 774 F.2d at 1123 (quoting *In re Owens-Corning Fiberglas Corp.*, 221 U.S.P.Q. 1195, 1198 (T.T.A.B. 1984)).

## Conclusion

In sum, the language, legislative history, administrative interpretation, and policies of the Lanham Act all indicate that Congress intended that color be afforded trademark protection in the appropriate circumstances. *Amicus curiae* Owens-Corning respectfully submits that this Court should reverse the judgment of the Ninth Circuit and reject the *per se* prohibition against the registration of colors as trademarks.

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